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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/276,484	03/25/1999	ALEXANDER GAIGER	210121.465C1	2160
500	7590	11/28/2005	EXAMINER	
SEED INTELLECTUAL PROPERTY LAW GROUP PLLC 701 FIFTH AVE SUITE 6300 SEATTLE, WA 98104-7092			SCHWADRON, RONALD B	
			ART UNIT	PAPER NUMBER
			1644	

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/276,484

**Applicant(s)**

GAIGER ET AL.

**Examiner**

Ron Schwadron, Ph.D.

**Art Unit**

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 35,37,63-69 and 104-109 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35,37,63-69,104-109 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

1. Claims 35,37,63-69,104-109 are under consideration.
2. The following is a quotation of the first paragraph of 35 U.S.C. 112:  
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
3. The rejection of claims 104 and 106 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for the reasons elaborated in the previous Office Action is withdrawn in view of the amended claims.
4. Claims 35-37, 63-69,104-109 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification is not enabling for the claimed methods. The specification does not disclose how to use the instant inventions for the in vivo treatment of disease in humans. Applicant has not enabled the breadth of the claimed invention in view of the teachings of the specification because the use for the instant invention disclosed in the specification is the in vivo treatment of disease in humans. The state of the art is such that is unpredictable in the absence of appropriate evidence as to how the instant invention could be used in vivo in humans.

Judge Lourie stated in Enzo Biochem Inc. v. Calgene Inc. CAFC 52 USPQ2d 1129 that:  
*The statutory basis for the enablement requirement is found in Section 112, Para. 1, which provides in relevant part that:*

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same. . . .*

*35 U.S.C. Section 112, Para. 1 (1994). "To be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.' " Genentech, Inc. v. Novo Nordisk, A/S , 108*

*F.3d 1361, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir. 1997) (quoting In re Wright , 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)). Whether claims are sufficiently enabled by a disclosure in a specification is determined as of the date that the patent application was first filed, see Hybritech, Inc. v. Monoclonal Antibodies, Inc. , 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), which in this case is October 20, 1983 for both the '931 and '149 patents.*

*We have held that a patent specification complies with the statute even if a "reasonable" amount of routine experimentation is required in order to practice a claimed invention, but that such experimentation must not be "undue." See, e.g., Wands , 858 F.2d at 736-37, 8 USPQ2d at 1404 ("Enablement is not precluded by the necessity for some experimentation . . . . However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue,' not 'experimentation.' ") (footnotes, citations, and internal quotation marks omitted). In In re Wands , we set forth a number of factors which a court may consider in determining whether a disclosure would require undue experimentation. These factors were set forth as follows:*

*(1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.*

*Id. at 737, 8 USPQ2d at 1404. We have also noted that all of the factors need not be reviewed when determining whether a disclosure is enabling. See Amgen, Inc. v. Chugai Pharm. Co., Ltd. , 927 F.2d 1200, 1213, 18 USPQ2d 1016, 1027 (Fed. Cir. 1991) (noting that the Wands factors "are illustrative, not mandatory. What is relevant depends on the facts.").*

Regarding Wands factors 4,5,7,8, the instant invention deals with methods for generating an immune response with the peptide recited in the claims. The substantial/real life use for the claimed invention is in vivo treatment of disease in humans. Tumor peptide vaccines are currently not used routinely in the treatment of human cancer. Thus, the state of the art is that it is unpredictable whether the claimed method can be used in vivo in humans. As per Wands factor (8), the claims encompass the treatment of human disease using the claimed composition and generation of an immune response including T cell responses such as CTL. The prior art recognizes that

T cell responses to T cell antigens are MHC restricted (eg. the peptide is recognized in the context of a self MHC/peptide complex, see Yewdell et al., page 53). The instant claims are not limited to a particular set of alleles which have been shown to bind the peptide recited in the claim. The specification indicates that the peptide recited in the claims would only bind several HLA allotypes (see Tables) wherein there are at least a hundred known alleles. Thus, it appears that the claimed method could not be used in most humans because they do not express an HLA allele which binds the peptide recited in the claims. In addition, the prior art discloses that prior to use in vivo in humans, it is appropriate to test whether a WT1 derived peptide generates human CTL (see Oka et al., page 56, second column, last paragraph, continued on next page). Such evidence is not provided in the specification. Furthermore, Yewdell et al. indicate that MHC binding in itself is not evidence that a peptide will actually generate a CTL response (for example see pages 56 and 57). In addition, the manufactures of the Ribi adjuvant system indicate that their reagent is not for use in humans (see page 2). It is also unclear as to what other adjuvants recited in the claims are suitable for human use. Regarding Wands factors 1-3, the specification provides no experimental data regarding the in vivo use of the peptide recited in the claims. There is also no evidence provided that the peptide recited in the claimed method can be recognized by human CTL. Regarding Wands factor 6, the relative skill of those in the art is high (eg. Ph.D. or M.D.). It appears that undue experimentation would be required of one skilled in the art to practice the instant invention using the teaching of the specification. See *In re Wands* 8 USPQ2d 1400(CAFC 1988).

Regarding applicants comments, the current rejection is not under 35 USC 101 and the PTO utility guidelines are not germane to the rejection under consideration. The current rejection is under 35 U.S.C. 112 first paragraph. The legal basis for the instant rejection is as per elaborated by Judge Lourie stated in Enzo Biochem Inc. v. Calgene Inc. CAFC 52 USPQ2d 1129. Judge Lourie stated in Enzo Biochem Inc. v. Calgene Inc. CAFC 52 USPQ2d 1129 that:

*The statutory basis for the enablement requirement is found in Section 112, Para. 1, which provides in relevant part that:*

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same. . . . 35 U.S.C. Section 112, Para. 1 (1994). "To be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.' "* *Genentech, Inc. v. Novo Nordisk, A/S* , 108 F.3d 1361, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright* , 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)). Whether claims are sufficiently enabled by a disclosure in a specification is determined as of the date that the patent application was first filed, see *Hybritech, Inc. v. Monoclonal Antibodies, Inc.* , 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), which in this case is October 20, 1983 for both the '931 and '149 patents.

*We have held that a patent specification complies with the statute even if a "reasonable" amount of routine experimentation is required in order to practice a claimed invention, but that such experimentation must not be "undue." See, e.g., Wands , 858 F.2d at 736-37, 8 USPQ2d at 1404 ("Enablement is not precluded by the necessity for some experimentation . . . . However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue,' not 'experimentation.' ") (footnotes, citations, and internal quotation marks omitted). In *In re Wands* , we set forth a number of factors which a court may consider in determining whether a disclosure would require undue experimentation. These factors were set forth as follows:*

*(1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. Id. at 737, 8 USPQ2d at 1404. We have also noted that all of the factors need not be reviewed when determining whether a disclosure is enabling. See *Amgen, Inc. v. Chugai Pharm. Co., Ltd.* , 927 F.2d 1200, 1213, 18 USPQ2d 1016, 1027 (Fed. Cir.*

*1991) (noting that the Wands factors "are illustrative, not mandatory. What is relevant depends on the facts.").*

The claims under consideration are not enabled for the reasons elaborated in the instant rejection as pertaining to the Wands factors. The prior art recognizes that T cell responses to T cell antigens are MHC restricted (eg. the peptide is recognized in the context of a self MHC/peptide complex, see Yewdell et al., page 53). The instant claims are not limited to a particular set of alleles which have been shown to bind the peptide recited in the claim. The specification indicates that the peptide recited in the claims would only bind several HLA allotypes (see Tables) wherein there are at least a hundred known alleles. Thus, it appears that the claimed method could not be used in most humans because they do not express an HLA allele which binds the peptide recited in the claims. Regarding applicants comments, the specification specifically discloses which alleles would be expected to bind the instant peptide. The specification indicates that the peptide recited in the claims would only bind several HLA allotypes (see Tables) wherein there are at least a hundred known alleles. Thus, it appears that the claimed method could not be used in most humans because they do not express an HLA allele which binds the peptide recited in the claims. Regarding applicants comments about clinical trials in page 9 of the instant amendment and applicants comments about the Ribit adjuvant system, there is no evidence of record that supports said assertions and applicants attorneys statements carry no weight. The MPEP section 2145, section I. discloses:

*The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness.").*

In addition, the prior art discloses that prior to use in vivo in humans, it is appropriate to test whether a WT1 derived peptide generates human CTL (see Oka et al., page 56,

second column, last paragraph, continued on next page). Regarding applicants comments about Example 5, said example is performed in mice not humans. Regarding the CORIXA Vaccine adjuvants information sheet, MPL is only one of the ingredients in RIBI adjuvant (see page 1 of previously supplied RIBI adjuvant fact sheet).

5. No claim is allowed.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ron Schwadron, Ph.D. whose telephone number is 571 272-0851. The examiner can normally be reached on Monday-Thursday 7:30-6:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571 272-0841. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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